



2653#36

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Dovek et al.
 Assignee: Maxtor Corporation
 Title: MAGNETIC STORAGE DEVICE WITH FLUX-GUIDED
 MAGNETORESISTIVE HEAD USING A PERPENDICULAR
 RECORDING MEDIA (AS AMENDED)
 Serial No.: 09/067,795 Filed: April 28, 1998
 Examiner: Letscher, G. Group Art Unit: 2652
 Atty. Docket No.: 3123-276

RECEIVED

COMMISSIONER FOR PATENTS
 P.O. Box 1450
 Alexandria, VA 22313

AUG 22 2003
 Technology Center 2600

PETITION TO ENTER RESPONSE

Dear Sir:

This Petition is filed under 37 C.F.R. § 1.181 to request that the Response filed on April 1, 2003 be entered.

I. FACTS

The Decision on Appeal dated March 26, 2003 ruled on the non-final rejection of claims 1-60. The Decision (1) sustained the rejection of 1-4, 6, 7, 11, 13-15, 17-19, 21, 24-27, 29-34, 37, 42-48, 50, 53, 57, 58 and 60 based on *Tanaka et al.* (U.S. Patent No. 5,486,967) and reversed the rejection of claims 10, 49 and 55 based on *Tanaka et al.*; (2) reversed the rejection of claims 1-60 based on *Hesterman et al.* (U.S. Patent No. 5,434,733) in view of *Hamilton* (U.S. Patent No. 4,423,450); and (3) reversed the rejection of claim 55 based on *Somers* (U.S. Patent No. 5,097,371) in view of *Hamilton*.

Thus, the outstanding rejections for claims 5, 8, 10, 12, 16, 20, 22, 28, 35, 36, 38, 39, 40, 41, 49, 51, 52, 54, 55, 56 and 59 were reversed.

In the Response filed on April 1, 2003, claims 1, 17 and 30 were amended, claims 5, 20 and 36 were cancelled, and claims 61-83 were added. The Response explained these amendments and new claims as follows:

Claim 1 has been amended to rewrite claim 5 in independent form including all the limitations of the base claim and any intervening claim.

Claim 17 has been amended to rewrite claim 20 in independent form including all the limitations of the base claim and any intervening claim.

Claim 30 has been amended to rewrite claim 36 in independent form including all limitations of the base claim and any intervening claims.

Claim 61 constitutes claim 8 rewritten in independent form including all limitations of the base claim and any intervening claims. Claim 62 depends from claim 61 and corresponds to claim 9.

Claim 63 constitutes claim 10 rewritten in independent form including all limitations of the base claim and any intervening claims.

Claim 64 constitutes claim 12 rewritten in independent form including all limitations of the base claim and any intervening claims.

Claim 65 constitutes claim 16 rewritten in independent form including all limitations of the base claim and any intervening claims.

Claim 66 constitutes claim 22 rewritten in independent form including all limitations of the base claim and any intervening claims. Claims 67-70 depend from claim 66 and correspond to claims 23-26, respectively.

Claim 71 constitutes claim 28 rewritten in independent form including all limitations of the base claim and any intervening claims.

Claim 72 constitutes claim 35 rewritten in independent form including all limitations of the base claim and any intervening claims.

Claim 73 constitutes claim 38 rewritten in independent form including all limitations of the base claim and any intervening claims.

Claim 74 constitutes claim 39 rewritten in independent form including all limitations of the base claim and any intervening claims.

Claim 75 constitutes claim 40 rewritten in independent form including all limitations of the base claim and any intervening claims.

Claim 76 constitutes claim 41 rewritten in independent form including all limitations of the base claim and any intervening claims.

Claim 77 constitutes claim 49 rewritten in independent form including all limitations of the base claim and any intervening claims.

Claim 78 constitutes claim 51 rewritten in independent form including all limitations of the base claim and any intervening claims.

Claim 79 constitutes claim 52 rewritten in independent form including all limitations of the base claim and any intervening claims.

Claim 80 constitutes claim 54 rewritten in independent form including all limitations of the base claim and any intervening claims.

Claim 81 constitutes claim 55 rewritten in independent form including all limitations of the base claim and any intervening claims.

Claim 82 constitutes claim 56 rewritten in independent form including all limitations of the base claim and any intervening claims.

Claim 83 constitutes claim 59 rewritten in independent form including all limitations of the base claim and any intervening claims.

The Advisory Action dated August 14, 2003, refused to enter the Response as an improper amendment to a final rejection as follows:

The amendment filed 4/7/03 after a decision by the Board of Patent Appeals and Interferences is not entered because prosecution is closed and Applicant's proposed new claim(s) present additional claims without canceling a corresponding number of finally rejected claims (37 CFR 1.116(c)). See also 37 CFR 1.198.. (Emphasis added.)

II. ARGUMENT

The Examiner deems the captioned-application under final rejection. This is clearly erroneous. As the Decision makes clear, the claims are under non-final rejection. For this reason alone, the refusal to enter the Response is improper.

37 C.F.R. § 1.116(c) states as follows:

If amendments touching the merits of the application or patent under reexamination are presented after final rejection, or after appeal has been taken, or when such amendment might not otherwise be proper, they may be admitted upon a showing of good and sufficient reasons why they are necessary and were not presented earlier.

37 C.F.R. § 1.198 states as follows:

Cases which have been decided by the Board of Patent Appeals and Interferences will not be reopened or reconsidered by the primary examiner except under the provisions of § 1.114 or § 1.196 without the written authority of the Commissioner, and then only for the consideration of matters not already adjudicated, sufficient cause being shown.

Neither Rule indicates that presenting new claims requires canceling a corresponding number of finally rejected claims. Moreover, the claims are not finally rejected.

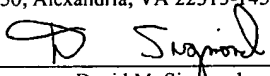
37 C.F.R. § 1.196(c) states as follows:

Should the decision of the Board of Patent Appeals and Interferences include an explicit statement that a claim may be allowed in amended form, appellant shall have the right to amend in conformity with such statement which shall be binding on the examiner in the absence of new references or grounds or rejection.

The Response dated April 1, 2003 complies with this Rule. Namely, the claims have been amended in conformity with the Decision. Accordingly, the Response should be entered.

Please charge any fee due under this Petition to Deposit Account No. 13-0016/276.

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on August 18, 2003.

 8, 18, 03

Date of Signature

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Respectfully submitted,



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